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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,543	01/12/2001	Walter Horburger	HF-54	1176

7590 07/16/2002

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EXAMINER

VERBITSKY, GAIL KAPLAN

ART UNIT PAPER NUMBER

2859

DATE MAILED: 07/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. 09/759,543	Applicant(s) Horburger et al.
Examiner Gail Verbitsky	Art Unit 2859

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on May 13, 2002

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle* 1035 C.D. 11; 453 O.G. 213.

4)  Claim(s) 1-5 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-5 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). 7(1pg)
- 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 1-2 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Goss et al. (U.S. 5749152) [hereinafter Goss] in view of Smith et al. (U.S. 3848417) [hereinafter Smith].

Goss discloses in Fig. 2 a spirit level comprising a bubble level (vial) 10, a bubble 46, a recess and a housing (level body) 54.

Goss does not explicitly disclose the particular material to make the level body.

Smith teaches that a float (level) can be made of a foamed aluminum (col. 8, line 32).

Therefore, it would have been obvious to one of ordinary skill to make the level disclosed by Goss of a foamed aluminum, as taught by Smith, so as to have a light weighted and corrosion free structure capable of floating.

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4. Claims 3 and 5 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Goss and Smith as applied to claims 1-2 above, and further in view of Hettinga (U.S. 4125490).

Goss and Smith disclose a device as stated above in paragraph 3.

They do not disclose a coating made of a synthetic material which is less porous than a foamed (porous) metal as stated in claims 3 and 5.

Hettinga discloses a level frame (outer surface) made of a smooth non-porous skin (coating) while the inside is made of a <sup>porous</sup> foamed material (col. 6, lines 48-49).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add a non-porous (less porous) coating, as taught by Hettinga, to the device disclosed by Goss and Smith, so as to protect the porous inside from contamination and moisture in order to maintain the required accuracy of the device.

5. Claim 4 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Goss and Smith as applied to claims 1-2 above, and further in view of Provi (U.S. 3889353).

Goss and Smith disclose a device as stated above in paragraph 3.

They do not disclose recesses (plurality) in the level body.

Provi discloses in Fig. 1 two recesses for vials (bubbles) 48.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device disclosed by Goss and Smith, so as to have two

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recesses for bubbles, as taught by Provi, in order to provide the user with more accurate level indication.

***Response to Arguments***

6. Applicant's arguments filed on May 13, 2002 have been fully considered but they are not persuasive.

With respect to claims 1-2:

Applicant states that Smith's float is to solve a different problem. This argument is not persuasive because:

A) Smith teaches that a float made of a foamed aluminum is floatable on a surface. Therefore, it would have been obvious to one of ordinary skill in the art that in order to make a device floatable on water, among other floatable materials, one skilled in the art can choose a foamed aluminum.

B) Also, it has been held that a recitation with respect to the manner in which claim apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Applicant states that Smith's device does not require a shape and accuracy as in the present invention and other features of the present invention. This argument is not persuasive because:

A) Smith reference is only used by Examiner for its teaching that a device made of a foamed aluminum can float and thus, can be used for a floatable level,

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B) the limitations upon which the applicant relies are not stated in the claims. It is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. *Constant v. Advanced Micro-Devices, Inc.*, 7 USPQ2d 1064.

With respect to claims 3-5:

Applicant states that the method of foaming disclosed by Hettinga can not be employed for foaming metal. This argument is not persuasive because the limitations upon which the applicant relies are not stated in the claims. It is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. *Constant v. Advanced Micro-Devices, Inc.*, 7 USPQ2d 1064. In the other words, nothing in claims 3 and 5 claims the particular method of making the level different from Hettinga. Hettinga discloses a device foamed inside and having a solid non-porous synthetic (plastic) outside (coating) as claimed by applicant. Only this teaching is used by the examiner.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited in the PTO-892 and not mentioned above disclose related devices.

9. Any inquiry concerning this communication should be directed to Examiner Verbitsky who can be reached at (703) 306-5473, Monday through Friday, 7:30 to 4:00 ET.

Any inquiry of general nature should be directed to the Group receptionist whose telephone number is (703) 308-0956.

GKV

July 11, 2002



*Diego Gutierrez*

*Supervisory Patent Examiner*

*TC 2800*